

ESTTA Tracking number: **ESTTA693488**

Filing date: **09/03/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91222961
Party	Defendant Heckler & Koch GmbH
Correspondence Address	DANIEL R COOPER COOPER & KURZ 170 EDEN ROAD STAMFORD, CT 06907 UNITED STATES kurzcooper@att.net
Submission	Answer
Filer's Name	Daniel R. Cooper
Filer's e-mail	kurzcooper@att.net
Signature	/drc/
Date	09/03/2015
Attachments	University of Southern California v HK GmbH Answer.pdf(2225897 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 79/150,583
Mark: USC
Published for Opposition: March 24, 2015

University of Southern California,)	
)	
Opposer,)	Opposition No. 91222961
)	
v.)	
)	
Heckler & Koch GmbH,)	Opposer's Ref.: 93107-00125
)	
Applicant.)	

Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

Heckler & Koch GmbH ("Applicant") answers the Notice of Opposition filed on July 22, 2015 by Opposer University of Southern California ("Opposer") as follows¹:

1. The allegation made in Paragraph 1 of the Notice of Opposition is ADMITTED.
2. The allegation made in Paragraph 2 of the Notice of Opposition is ADMITTED

subject to the following clarification of the record: Applicant's name is *Heckler &*

¹ At the outset, Applicant notes that the caption of Opposer's Notice of Opposition erroneously lists "Carolina Collegiate Federal Credit Union" as the Applicant for U.S. Trademark Application Serial No. 79/150,583. The true name of Applicant is, almost, correctly reflected in Paragraph 2 of the Notice of Opposition [see Paragraph 2 above/below]. Nevertheless, Applicant respectfully brings this to the Board's (and Opposer's) attention and hopes the record will be corrected accordingly in short order.

Koch GmbH (emphasis added) and has its principal place of business at *Heckler* & Koch Str. 1, 78727 Oberndorf, Germany (emphasis added).²

3. The allegation made in Paragraph 3 of the Notice of Opposition is ADMITTED.
4. Applicant is without sufficient knowledge or information to either admit or deny the truth of the allegations made in Paragraph 4 of the Notice of Opposition, and therefore DENIES the same.
5. To the extent that Opposer is named as the current owner of record for U.S. Trademark Registration No. 2,319,979, this allegation is ADMITTED by Applicant. However, Applicant is without sufficient knowledge or information to either admit or deny that either: (a) Opposer is currently the true owner of U.S. Trademark Registration No. 2,319,979 (“the ‘979 Registration”); or (b) it was the owner on the date the application that matured into the ‘979 Registration was filed. Applicant therefore DENIES that Opposer is the owner of the ‘979 Registration, as alleged in Paragraph 5 of the Notice of Opposition. Further, Applicant is without sufficient knowledge or information to either admit or deny that the ‘979 Registration is “valid, subsisting, and incontestable” (again, as alleged in Paragraph 5 of the Notice of Opposition) and therefore DENIES the same. Finally, Applicant is without sufficient knowledge or information as to the territorial scope of the ‘979 Registration, as mentioned in Paragraph 5 of the Notice of Opposition, and therefore DENIES this assertion as well.

² Paragraph 2 of the Notice of Opposition has a, in Applicant’s view, significant typographical error: i.e., its name is misspelled. It is, of course, Heckler & Koch, not “Hekler.” This applies with equal force to record street address.

6. To the extent that Opposer is named as the current owner of record for U.S. Trademark Registration No. 1,689,594, this allegation is ADMITTED by Applicant. However, Applicant is without sufficient knowledge or information to either admit or deny that either: (a) Opposer is currently the true owner of U.S. Trademark Registration No. 1,689,594 (“the ‘594 Registration”); or (b) it was the owner on the date the application that matured into the ‘594 Registration was filed. As such, Applicant DENIES that Opposer is the owner of the ‘594 Registration, as alleged in Paragraph 6 of the Notice of Opposition. Further, Applicant is without sufficient knowledge or information to either admit or deny that the ‘594 Registration is “valid, subsisting, and incontestable” (as alleged in Paragraph 6 of the Notice of Opposition) and therefore DENIES the same. Finally, Applicant is without sufficient knowledge or information to either admit or deny the truth of Opposer’s assertion that it has “used the USC mark and various related marks in connection with clothing since at least 1990,” and therefore DENIES the truth of this assertion as well.
7. To the extent that Opposer is named as the current owner of record for U.S. Trademark Registration No. 1,240,848 this allegation is ADMITTED by Applicant. However, Applicant is without sufficient knowledge or information to either admit or deny that either: (a) Opposer is currently the true owner of U.S. Trademark Registration No. 1,240,848 (“the ‘848 Registration”); or (b) it was the owner on the date the application that matured into the ‘848 Registration was filed. As such, Applicant DENIES that Opposer is the owner of the ‘848 Registration, as alleged in Paragraph 7 of the Notice of Opposition. Further,

Applicant is without sufficient knowledge or information to either admit or deny that the '848 Registration is "valid, subsisting, and incontestable" and therefore DENIES the same. Finally, Applicant is without sufficient knowledge or information to admit or deny that Opposer has used the mark in connection with the goods identified in the '848 Registration, and therefore DENIES the truth of this allegation as well.

8. To the extent that Opposer is named as the current owner of record for U.S. Trademark Registration No. 4,542,209 this is ADMITTED by Applicant. However, Applicant is without sufficient knowledge or information to either admit or deny that either: (a) Opposer is currently the true owner of U.S. Trademark Registration No. 4,542,209 ("the '209 Registration"); or (b) it was the owner on the date the application that matured into the '209 Registration was filed. As such, Applicant DENIES that Opposer is the owner of the '209 Registration, as alleged in Paragraph 8 of the Notice of Opposition. Further, Applicant is without sufficient knowledge or information to either admit or deny that the '209 Registration is "valid" or "subsisting" and therefore DENIES the same. However, Applicant emphatically DENIES that the '209 Registration has become incontestable. Finally, Applicant is without sufficient knowledge or information to admit or deny that Opposer has used the mark in connection with the services identified in the '209 Registration, and therefore DENIES this as well.

9. To the extent that Opposer is named as the current owner of record for U.S. Trademark Registration No. 2,711,042 this is ADMITTED by Applicant.

However, Applicant is without sufficient knowledge or information to either admit or deny that either: (a) Opposer is currently the true owner of U.S. Trademark Registration No. 2,711,042 (“the ‘042 Registration”); or (b) it was the owner on the date the application that matured into the ‘042 Registration was filed. As such, Applicant DENIES that Opposer is the owner of the ‘042 Registration, as alleged in Paragraph 9 of the Notice of Opposition.³ Further, Applicant is without sufficient knowledge or information to either admit or deny that the ‘042 Registration is “valid, subsisting, and incontestable” and therefore DENIES the same. Finally, Applicant is without sufficient knowledge or information to admit or deny that Opposer has used the mark in connection with the services identified in the ‘042 Registration, and therefore DENIES this as well.

10. To the extent that Opposer is named as the current owner of record for U.S.

Trademark Registration No. 2,718,936 this is ADMITTED by Applicant.

However, Applicant is without sufficient knowledge or information to either admit or deny that either: (a) Opposer is currently the true owner of U.S.

Trademark Registration No. 2,718,936 (“the ‘936 Registration”); or (b) it was the owner on the date the application that matured into the ‘936 Registration was filed. As such, Applicant DENIES that Opposer is the owner of the ‘936

Registration, as alleged in Paragraph 10 of the Notice of Opposition. Further,

³ Opposer also lists the classes of the ‘042 Registration as “International Classes 35 and 200.” This is, obviously, also erroneous. Applicant believes that Opposer meant to assert that the ‘042 Registration is also for U.S. Class 200 (there is no international class past Class 45, *see generally*, <http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20150101/taxonomy/> (last viewed, September 1, 2015)) and would be willing to stipulate that the ‘042 Registration lists services in US Class 200.

Applicant is without sufficient knowledge or information to either admit or deny that the '936 Registration is "valid, subsisting, and incontestable" and therefore DENIES the same. Finally, Applicant is without sufficient knowledge or information to admit or deny that Opposer has used the mark in connection with the services identified in the '936 Registration, and therefore DENIES this as well.

11. The allegations made in Paragraph 11 of the Notice of Opposition are, individually and collectively, DENIED.
12. The allegations made in Paragraph 12 of the Notice of Opposition are, individually and collectively, DENIED.
13. The allegations made in Paragraph 13 of the Notice of Opposition are, individually and collectively, DENIED.
14. The allegations made in Paragraph 14 of the Notice of Opposition are, individually and collectively, DENIED.
15. The allegations made in Paragraph 15 of the Notice of Opposition are, individually and collectively, DENIED.
16. The allegations made in Paragraph 16 of the Notice of Opposition are, individually and collectively, DENIED.
17. The allegation made in Paragraph 17 of the Notice of Opposition is DENIED.
18. The allegation made in Paragraph 18 of the Notice of Opposition is DENIED.
19. Applicant ADMITS that, if registration were conferred, Applicant would obtain the *prima facie* exclusive right to use the USC mark in the United States.

However, Applicant DENIES that "[s]uch registration would cause damage and

injury to Opposer” as asserted by Opposer in Paragraph 19 of the Notice of Opposition.

20. Applicant has used its USC mark in connection with goods for which registration is sought since at least November 1999. It has therefore acquired substantial common law rights and consumer goodwill in the USC mark in respect of the goods for which registration is sought.

21. Since November 1999, Opposer has not objected to Applicant’s use of its USC mark in the United States, though it has had at least constructive knowledge of Applicant’s use of its USC mark.

22. Therefore, Opposer’s claims of: (a) likelihood of confusion; and (b) dilution [unspecified], are estopped by acquiescence.

WHEREFORE, Applicant prays that the Opposition be dismissed with prejudice.

Respectfully Submitted,

HECKLER & KOCH GmbH

DATED: September 3, 2015

By: 

Daniel R. Cooper
Cooper & Kurz
170 Eden Road
Stamford, CT 06907-1007
Tel. (203) 322-4852
Fax. (203) 329-7881
kurzcooper@att.net

Attorney for Applicant

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 2.119, the undersigned hereby certifies that the foregoing
“Answer to Notice of Opposition” was served on Opposer through its attorney, Mr.
Michael S. Adler, Esq. of Tantalo & Adler LLP, via first class mail, postage prepaid, at
the following address:

Michael S. Adler, Esq.
1901 Avenue of the Stars, Suite 1000
Los Angeles, CA 90067

on this, the 3rd day of September, 2015.



Dr. Isolda Kurz Cooper
Cooper & Kurz
170 Eden Road
Stamford, CT 06907-1007
Tel. (203) 322-4852
Fax. (203) 329-7881
kurzcooper@att.net